

Appl. No. 10/765,622  
Reply dated Dec. 30, 2005  
Response to Office action of October 5, 2005

**Amendments to the Drawings:**

The attached sheet of drawings includes FIGURES 8 and 8B.

Attachment: FIGURES 8 and 8B

## **REMARKS**

In the specification, the paragraphs [0017], [0026], and [0027] has been amended to reflect the addition of FIGURES 8 and 8B.

Claims 1-7, 10-16, 19-25, 28-38, and 41-45 remain in this application. Claims 8, 9, 17, 18, 26, 27, 39, and 40 have been canceled. Claims 46-51 have been added.

### **I. CLAIM REJECTIONS – 35 USC § 112**

#### **A. Examiner's Statements**

The examiner rejected Claims 2, 4, 7, 9, 14, 16, 17, 20, 22, 25, 27, 36, 38, and 39 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as the invention. The examiner mentioned that Claim 2 states that the retainer engages the entire perimeter but that the perimeter has not been defined in the specification. The examiner also noted that none of the applicants' embodiments seem to engage the entire perimeter. The examiner also noted that Claim 4 states that the expansion cavity is located around the entire perimeter. The examiner requested clarification of the claims.

#### **B. Law**

A claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.<sup>1</sup> In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.<sup>2</sup> Breadth of a claim is not to be equated with indefiniteness.<sup>3</sup> If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute [35 U.S.C. §112, second paragraph] demands no more.<sup>4</sup>

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<sup>1</sup> *In re Swinehart*, 439 F.2d 210, 160 U.S.P.Q. 226 (CCPA 1971).

<sup>2</sup> *See, e.g., Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 U.S.P.Q.2d 1279, 1283 (Fed. Cir. 2000).

<sup>3</sup> *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971).

<sup>4</sup> *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986).

**C. Claims 2, 4, 7, 9, 14, 16, 17, 20, 22, 25, 27, 36, 38, and 39**

The applicants amend the claims to more clearly define what is meant by engaging the entire perimeter with the retainer. The applicants also add Figures 8 and 8B to illustrate the seal pad configured to laterally retain the entire perimeter of the expandable material in a lateral plane of expansion of the expandable material when sealed against the borehole wall. The submission of new drawings 8 and 8B does not constitute new matter as the information in the drawings is fully supported by the specification and the original set of claims. The applicants submit that these amendments overcome the Examiner's rejections and respectfully request that the rejections be removed.

**II. CLAIM REJECTIONS – 35 USC § 102**

**A. Examiner's Statements**

The examiner rejected Claims 1, 3, 5, 6, 8, 10, 11, 13, 15, 18, 19, 21, 23, 24, 26, 28, 29, 32, 35, 37, 40, and 44 under 35 U.S.C. § 102(b) as being anticipated by Bretzke, Jr. (U.S. Patent No. 3,173,485) ("Bretzke").

**B. Law**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>5</sup> The identical invention must be shown in as complete detail as is contained in the ... claim.<sup>6</sup> To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."<sup>7</sup> Thus, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.<sup>8</sup> In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>9</sup> In addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and

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<sup>5</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

<sup>6</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

<sup>7</sup> *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

<sup>8</sup> *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

<sup>9</sup> *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention.<sup>10</sup>

**C. Claims 1, 3, 5, 6, 8, 10, 11, 13, 15, 18, 19, 21, 23, 24, 26, 28, 29, 32, 35, 37, 40, and 44**

Claims 1, 3, 5, 6, 8, 10, 11, 13, 15, 18, 19, 21, 23, 24, 26, 28, 29, 32, 35, 37, 40, and 44 of the present application require a retainer configured to retain at least a portion of the expandable material that is expanded when sealed against the borehole wall in a lateral plane of expansion of the expandable material. Bretzke, however, only discloses backing members 58 used to support the “back” of the seal pad 44 with respect to the direction of engagement with the borehole wall. The backing members 58, although support members, do not serve to retain any portion of the expandable material that is expanded in a lateral plane of expansion when sealed against the borehole wall. Thus, Bretzke does not satisfy the requirement of the claims that the retainer retain at least a portion of the expandable material in a lateral plane of expansion when sealed against the borehole wall. As such, the applicants respectfully submit that Bretzke does not disclose all of the limitations of the claims and requests that the Examiner remove the rejection with respect to the claims.

**III. CLAIM REJECTIONS - 35 U.S.C. § 103**

**A. Examiner’s Statements**

The Examiner rejected Claims 12 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Bretzke, Jr. The Examiner also rejected Claims 33, 34, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Bretzke in view of Hill, et al. (U.S. Patent Application Publication No. 2005/0155760) (“Hill”). The Examiner also rejected Claims 31, 41, and 45 under 35 U.S.C. § 103(a) as being unpatentable over Bretzke in view of Fox, et al. (U.S. Patent Application Publication No. 2004/0173351) (“Fox”).

**B. Law**

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>11</sup> If the examiner does not produce a *prima facie* case, the applicants are under no obligation to submit evidence of nonobviousness.

To establish a *prima facie* case of obviousness, the following tenets of patent law must be adhered to: (a) the claimed invention must be considered as a whole; (b) the references must be

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<sup>10</sup> *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

<sup>11</sup> *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (c) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (d) reasonable expectation of success is the standard with which obviousness is determined.<sup>12</sup> Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.<sup>13</sup>

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>14</sup> Thus, a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.<sup>15</sup> Additionally, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.<sup>16</sup>

Also, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.<sup>17</sup> In addition, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.<sup>18</sup>

### **C. Claims 12, 30, 31, 33, 34, 41, 42, 43, and 45**

Claims 12, 30, 31, 33, 34, 41, 42, 43, and 45 depend from independent Claims 1, 13, 19, and 35, respectively. The applicants repeat and incorporate by reference the remarks made above with respect to independent Claims 1, 13, 19, and 35. If an independent claim is nonobvious under 35

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<sup>12</sup> *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5 (Fed. Cir. 1986).

<sup>13</sup> *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991).

<sup>14</sup> *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

<sup>15</sup> *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *see also In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

<sup>16</sup> *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

<sup>17</sup> *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

<sup>18</sup> *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).

U.S.C. § 103, then any claim depending therefrom is nonobvious.<sup>19</sup> Therefore, the applicants respectfully request that the examiner remove the rejection with respect to dependent claims 12, 30, 31, 33, 34, 41, 42, 43, and 45 as well.

#### **IV. AMENDMENTS MADE NOT RELATED TO PATENTABILITY**

The applicants have amended Claims 1, 19, and 35 to more clearly, correctly, and properly claim the invention and not for purposes of patentability. Specifically, the preamble of the claims was amended to indicate that the formation, borehole, and borehole wall were not positively claimed.

These statements are not an admission that the other amendments were made for purposes of patentability, meant to be limiting in any way, or meant to be all-inclusive of amendments not made for purposes of patentability.

#### **V. STATEMENT REGARDING CLAIMS**

The applicants comment on the allowability of the claims by addressing the examiner's comments in this paper as well as previously during the prosecution of this application. By doing so, the applicants are in no way limiting their ability to argue additional points of novelty regarding the independent claims or dependent claims at a later date.

#### **CONCLUSION**

The applicants respectfully request reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, the applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless the applicants have specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although the applicants may have amended certain claims, the applicants have not abandoned their pursuit of obtaining the allowance of

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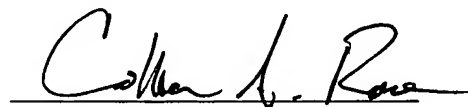
<sup>19</sup> *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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these claims as originally filed and reserve, without prejudice, the right to pursue these claims in a continuing application.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-48300) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,  
CONLEY ROSE, P.C.

A handwritten signature in black ink, appearing to read "Collin A. Rose", is written over a horizontal line.

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Attachments